



Paper No. 11

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OFFICE OF PETITIONS

In re Application of
Brock, et al.
Application No: 09/811,978
Filed: March 19, 2001
Attorney Docket No. JONAT.008A
For: COMPUTER SERVER MOUNTING
APPARATUS

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:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)
:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed August 4, 2003 (certificate of mailing date July 31, 2003), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to prior-filed provisional Application No. 60/190,153, filed March 17, 2000.

The instant pending nonprovisional application was filed on March 19, 2001, within twelve months of the filing date of the prior provisional application, Application No. 60/190,153, which was filed on March 17, 2000, and for which priority is claimed.¹ While a reference to the prior-filed provisional application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the oath or declaration.

The current procedure where a claim for priority under 37 CFR 1.78(a)(5) is not included the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(5). However, on the other hand, if the USPTO does not note the claim for priority to the provisional application in the oath or declaration or transmittal letter submitted with the application, a petition will be

¹ March 17, 2001 was a Saturday. Thus petitioner had until the first business day after the weekend -- Monday, March 19, 2001-- to file the nonprovisional application.

required to accept a late claim for priority under 37 CFR 1.78(a)(6).² In the instant case, the Office noted the claim for priority of provisional Application No. 60/190,153 in the oath or declaration, as shown by its inclusion on the filing receipt.

In view of the above, the \$1,300 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

It is noted the part of the amendment relating to the benefit claim is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:


Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See In re de Seversky, *supra*. Note also MPEP 201.06(c).

Accordingly, petitioner must submit an amendment³ deleting the incorporation by reference statement in the benefit claim.

Any questions concerning this matter may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center AU 3632 for processing the amendment filed August 4, 2003. However, as stated above, the examiner will not consider the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior provisional Application No. 60/190,153, filed on March 17, 2000, until an acceptable amendment relating to benefit is filed.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

² 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

³ 37 CFR 1.121